

REMARKS

Claims 1 and 3-19 are pending. By this Amendment, claims 1, 3, 6 and 10 are amended, claim 2 is canceled and claims 14-19 are added. The claim amendments are made for clarity, not for distinguishing applied art. The subject matter recited in claims 14 and 15 is supported by the specification at least at page 25, for example; the subject matter recited in claim 16 is supported by the specification at least on pages 31-33, for example; and the subject matter recited in claims 17-19 is supported by the specification at least by Fig. 1, page 15 and page 17, for example. Thus, no new matter is introduced.

The Office Action did not acknowledge the claim for foreign priority indication in the application transmittal filed on February 23, 2004, and did not indicate receipt of the certified copies of the priority foreign applications. Applicants respectfully request acknowledgement of the claim for priority and an indication that the certified copies of the priority foreign applications have been received.

Applicants appreciate the initialed Form PTO-1449 indicating that four of the seven references submitted in the July 13, 2004 Information Disclosure Statement were considered. However, the Examiner did not initial the three Japanese documents that were submitted with Abstract and translation. Applicants respectfully request consideration of the three Japanese references (copy enclosed including the Japanese references, English Abstract and computer English-language translations) indicated in the July 13, 2004 Form PTO-1449.

Applicants appreciate the Office Action indication that claim 13 contains allowable subject matter. However, Applicants respectfully submit that all claims 1-12 and 14-19 prior to amendment are allowable as discussed in the remarks below.

The Office Action rejects claims 1, 3 and 6 under 35 U.S.C. §102(b) over Sugaya et al. (U.S. Patent No. 5,680,200); implicitly rejects claims 2, 4, 5, and 7-11 over Sugaya; and

rejects claim 12 under 35 U.S.C. §103 over Sugaya in view of Bae (U.S. Patent No. 5,766,809). These rejections are respectfully traversed.

The Office Action asserts that Sugaya disclosed compensating a difference in asymmetry ... that depends on the wavelength of said illumination light ..., as recited in unamended claims 1, 3 and 6 citing Sugaya Fig. 19 and C27/L34-C29/L41. However, Sugaya did not disclose or suggest compensating any differences in asymmetry that depended on wavelength of the illumination light. Instead, Sugaya detected an amount of asymmetric aberration, amount of symmetric aberration and amount of eclipse in the image-forming optical system based on the change in asymmetry of the phase pattern image under individual defocus conditions. See Sugaya, C27/L34-41. There is nothing in Sugaya that is directed to a difference in asymmetry of an image signal that depends on wavelength of the illumination light. Thus, Sugaya did not disclose or suggest the subject matter recited in claims 1, 3 and 6.

The Office Action asserts that Sugaya also disclosed adjusting said optical element in such a way that illumination wavelength dependency of the image signal becomes minimum, as recited in unamended claim 10. However, as discussed above, Sugaya did not disclose any subject matter regarding wavelength dependency. Thus, Sugaya did not disclose the subject matter recited in claim 10.

Regarding unamended claim 12, Bae is directed to testing overlay in a semiconductor device using inclined measuring marks and did not disclose or suggest any subject matter relating to minimizing a difference in asymmetry that depends on wavelength of illumination light or adjusting an optical element to minimize the wavelength dependency.

In view of the above, Sugaya and Bae individually or in combination did not disclose or suggest the subject matter recited in claims 1, 3, 6 and 10. Claims 4 and 5 depend from claim 1; claims 7-9 depend from claim 6; and claims 11 and 12 depend from claim 10. Thus, Sugaya and Bae, individually or in combination, did not disclose or suggest the subject matter

recited in claims 1 and 3-12. Withdrawal of the rejection of claims 1 and 3-11 under 35 U.S.C. §102 and claim 12 under 35 U.S.C. §103 is respectfully solicited.

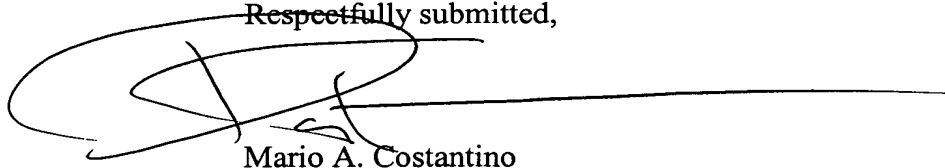
Claims 1, 3, 6 and 10 have been amended for clarity but not to overcome the asserted prior art. In particular, claims 1, 3, 6 and 10 are amended to recite compensates/compensating/minimizing a difference ... caused by a shorter wavelength range and a longer wavelength range. Thus, claims 1, 3, 6 and 10 are allowable over Sugaya and Bae for at least the reasons discussed above in connection with unamended claims 1, 3, 6 and 10.

Further, new claims 14 and 17 depend from claim 1, new claims 15 and 18 depend from claim 3, new claim 16 depends from claim 10 and new claim 19 depends from claim 6. Thus, new claims 14-19 are also allowable at least for the same reasons discussed above in connection with claims 1, 3, 6 and 10.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of claims 1 and 3-19 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'Mario A. Costantino', written over a horizontal line.

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Attachments:

Japanese references, their English-language Abstracts
and computer translations submitted with the
July 13, 2004 Information Disclosure Statement

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